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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,820	03/04/2004	Naoto Watanabe	03500.017940	3654

5514 7590 07/21/2006

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EXAMINER
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BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/791,820	WATANABE ET AL.	
	Examiner	Art Unit	
	Mark J. Beauchaine	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is in response to Applicant's amendment dated 26 May 2006 with was forwarded in response to final Office action dated 28 February 2006. The final Office action included a finding of persuasiveness of Applicant's arguments of amendment dated 6 January 2006 (page 11, lines 10-15) regarding claims 1-6. After further consideration of prior art said finding of persuasiveness is hereby withdrawn. Accordingly, the finality of Office action dated 28 February 2006 is hereby withdrawn.

### ***Specification***

The substitute specification dated 26 May 2006 has been considered and has been entered in the file of record.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "to stack sheets" (line 3) is ambiguous since it is not clear what causes sheets to be stacked onto the first tray.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Patent Number US 6,494,453 B1 by Yamada et al ("Yamada"). Yamada discloses first tray 1 that is located a stacking position at outlet E2 and movable to a retracted position above the stacking position, tray 2 that is positioned at a stacking position of outlet E2 and movable to a second retracted position below the stacking position. Yamada further discloses controller 102 that causes the second tray to descend and stop when the second tray reaches a standby position. Specifically, when sensor SN8 detects a top surface of a sheet on tray 2 the tray stops descending (column 9, lines 24-33). The distance between the outlet and the top surface of the sheets on the second tray is a predetermined distance since the distance between outlet E2 and sensor SN8 is a predetermined distance.

Regarding claim 2, the sensor SN8 of Yamada detects sheets on second tray 2 when said tray is in a standby position. Controller 102 causes said tray to descend and stop the descending movement just before the top sheet of the stack on said tray passes below said sensor causing the sensor to change from "sheet present" to "sheet absent".

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Regarding claims 4 and 6, second tray 2 descends and controller 102 causes said tray to stop when second sensor SN10 detects said tray at a lower limit (column 20, line 30-34) regardless of the output of sensor SN8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada as applied to claim 1 above, and further in view of Patent Number 5,228,679 by Borostyan ("Borostyan"). Borostyan teaches a controller that causes tray 114 to ascend in response to sheets being removed from said tray (column 7, lines 55-69). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ascending feature of Borostyan into the apparatus of Yamamoto to maintain the position of the top of the sheet stack at the outlet of the apparatus.

### ***Response to Arguments***

Applicant's arguments filed 6 January 2006 directed to claims 1-6 have been fully considered but they are not persuasive. Despite the Applicant's argument that independent claim 1 is patentable over Yamamoto (page 11, lines 10-15), Yamamoto discloses a predetermined distance from the apparatus outlet and the top surface of the sheet stack as explained above.

### ***Conclusion***

Claims 1-6 are rejected. Claims 7-15 have been canceled by the Applicant. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571)272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb

A handwritten signature in black ink that reads "Kathy Matecki". The signature is written in a cursive, flowing style.

**KATHY MATECKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**